

REMARKS

Reconsideration of this application is respectfully requested in view of the the following remarks.

Claims 1-33, 42-74, and 89-96 are pending in this application. No amendments are presented. No new matter is introduced. Thus, claims 1-33, 42-74 and 89-96 are currently pending in the application and subject to examination. Reconsideration and prompt allowance of the claims are respectfully requested.

In the Office Action mailed May 17, 2005, the Examiner stated that claims 1-4, 6-12, 13-22, 24-27, 29-33, 42-45, 48-62, 64-68, 70-74, 86-89, 91-93, 95, and 96 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Boulton (US Patent No. 4,985,697), hereinafter "Boulton", in view of Morales (US Patent No. 5,663,757), hereinafter "Morales". The Examiner stated that claims 46, 49, 90, and 94 were rejected as being allegedly unpatentable over Boulton in view of Morales and further in view of Pocock et al. (US Patent No. 5,014,125), hereinafter "Pocock".

Applicants note that no grounds of rejection for claims 5, 9, 13, 14, 23, 28, 29, 54, 55, 64, 69, 89-91 and 94 were set forth in the Office Action. Therefore, it is assumed that these claims are allowable.

I. The Cited Art Does Not Disclose Every Limitation in the Claims

A. Independent Claim 1

Claim 1 recites a method for providing electronic commerce using an electronic book, comprising displaying an electronic book, presenting associated with the electronic book an identification of a product or service; receiving a user's selection of

the product or service and a request to purchase the selected product or service; and performing a transaction to execute the purchase request.

Applicants submit that Boulton and Morales do not describe or suggest at least the limitation of presenting associated with the electronic book an identification of a product or service. Morales does not display electronic books and thus cannot present a product or service associated with the electronic book. Furthermore, Boulton does not disclose or suggest displaying a product or service associated with an electronic book. The first selection noted by the Examiner in Boulton disclosed different embodiments or modes of display that the user may select. The second selection in Boulton disclosed an index for the display. Neither Morales nor Boulton disclose or suggest the claimed element of presenting associated with the electronic book an identification of a product or service.

For at least this reason, Applicants submit that claim 1 is allowable over the prior art. As claim 1 is allowable, Applicants submit that claims 2-4, 6-8, 10-12, 15-22, 24-27, and 30-33, which depend from allowable claim 1, are likewise allowable for at least the reasons set forth above for claim 1.

B. Independent Claim 42

Claim 42 recites an apparatus for providing electronic commerce using an electronic book, comprising: a display module for displaying an electronic book; a presentation module for presenting associated with the electronic book an identification of a product or service; a receive module for receiving a user's selection of the product or service and a request to purchase the selected product or service; and an execution module for performing a transaction to execute the purchase request.

Applicants submit that Boulton and Morales do not describe or suggest at least the limitation of a presentation module for presenting associated with the electronic book an identification of a product or service. As discussed for claim 1 above, Morales does not disclose or suggest displaying an electronic book. Thus, a product or service associated with such a book cannot be displayed. Furthermore, as discussed above, Boulton does not disclose or suggest a presentation module for presenting associated with the electronic book an identification of a product or service.

For at least this reason, Applicants submit that claim 42 is allowable over the cited prior art. As claim 42 is allowable, Applicants submit that claims 43-53, 56-63, 65-68, and 70-74, which depend from allowable claim 42, are likewise allowable for at least the reasons set forth above for claim 42.

C. Independent Claim 93

Claim 93 recites an apparatus for providing electronic commerce using an electronic book comprising: a display module for displaying an electronic book; a presentation module for presenting associated with the electronic book an identification of a product or service; a receive module for receiving a user's selection of the product or service and a request to purchase the selected product or service; and an execution module for performing a transaction to execute the purchase request, wherein the execution module includes: a module for receiving from the user an offered price for the product or service; a determination module for determining whether to accept the offered price; and a transmission module for selectively transmitting an indication of an acceptance of the offered price based upon the determining.

Applicants submit that Boulton and Morales do not describe or suggest at least the combination of limitation of a determination module for determining whether to accept the offered price. Boulton never discloses or suggests anything connected to price, offers, or requests to purchase. Thus, Boulton does not disclose or suggest anything relating to a determination module for determining whether to accept the offered price. Likewise, Morales does not disclose or suggest the ability for a user to make a price offer. Morales does not disclose or suggest a determination module for determining whether to accept the offered price.

For at least this reason, Applicants submit that claim 93 is allowable over the cited prior art. As claim 93 is allowable, Applicants submit that claims 95-96, which depend from allowable claim 93, are likewise allowable for at least the reasons set forth above for claim 93.

II. There is an Improper Motivation to Combine References

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that

individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 3 and 4. This is an insufficient showing of motivation.

Examiner states on page 3 of the Office Action, in regards to claims 1 and 42 that it would have been obvious to one of ordinary skill in the art to make the combination because "it would provide real-time instantaneous purchases of product or service." However, Boulton does not disclose anything relating to the purchase of product or service. There is no motivation given for making an alteration to Boulton to include the purchase of a product or service. Thus, the stated reason of providing real-time, instantaneous purchases does not relate to the Boulton. The rejection is improper.

For at least this reason, Applicants submit that claims 1 and 42 are allowable over the cited prior art. As claims 1 and 42 are allowable, Applicants submit that claims 2-4, 6-8, 10-12, 15-22, 24-27, and 30-33, which depend from allowable claim 1, and claims 43-53, 56-63, 65-68, and 70-74, which depend from allowable claim 42, are likewise allowable over the cited prior art.

Furthermore, the Examiner takes Official Notice on page 4 of the Office Action that the missing element of "determining whether to accept the offered price" was

obvious because it “would have been obvious to one of ordinary skill in the art at the time the invention was made to look for bargain[s] such as discount[s], rebates on some of the products’ offered prices as this becomes a norm now in the internet age for customers to book for the best available price or deal for a particular product.”

Examiner appears to argue that it would have been obvious for a customer to make a determination based on price in order to find a bargain. This does not relate to the missing claimed element. Claim 93 recites in part a module for receiving from the user an offered price for the product or service; a determination module for determining whether to accept the offered price. The offered price is sent from the user, and the determination module is a part of the invention. The given obviousness reasoning relates to a user making a determination based on price, not a module determining whether to accept an offered price from a user. The rejection is improper.

For at least this reason, Applicants submit that claim 93 is allowable over the cited prior art. As claim 93 is allowable, Applicants submit that claims 95-96, which depend from allowable claim 93, are likewise allowable over the cited prior art.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Furthermore, claims 5, 9, 13, 14, 23, 28, 29, 54, 55, 64, 89-91, and 94 are allowable, as no basis for rejection was set forth in the Office Action. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited. Should the Examiner determine that any

further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300 with reference to docket number 026880-00011.

Respectfully submitted,

Arent Fox PLLC

A handwritten signature in black ink, appearing to read 'Charles Marmelstein', written over a horizontal line.

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